

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie

Serial No.: 09/376,461

Filed: August 18, 1999

For: SKYLIGHT FLASHING

Art Unit: 3634

Examiner: Cohen

1128.006A

June 2, 2003

750 B Street, Suite 3120

San Diego, CA 92101

TRANSMITTAL LETTER FOR NOTICE OF APPEAL; APPEAL BRIEF


Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

In connection with the Office Action dated May 14, 2003, enclosed herewith are the following:

- (1) A Transmittal Letter
- (2) A Notice of Appeal
- (3) Appeal Brief in 9 pages, in triplicate
- (4) Acknowledgment postcard.

Respectfully submitted,


John L. Rogitz, Attorney of Record
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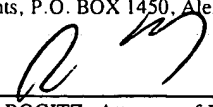
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Enclosures

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CERTIFICATE OF EXPRESS MAILING

I hereby certify that this document, together with any papers described as attached or enclosed, is being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" service, Express Mailing label No. EV331255091 US under 37 CFR §1.10, addressed to Mail Stop: Board of Patent Appeals and Interferences, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313 on JUNE 3, 2003.

Date Signed: JUNE 3, 2003


JOHN L. ROGITZ, Attorney of Record
Registration No. 33,549

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Serial No.: 09/376,461)	Examiner: Cohen
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)	San Diego, CA 92101
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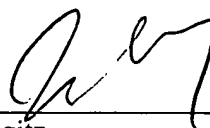
NOTICE OF APPEAL

Commissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

The Office Action dated May 14, 2003 is hereby appealed.

Respectfully submitted,



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AND INTERFERENCES

1128-6.AP1

(1) Real Party in Interest

The real party in interest is the assignee.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 3, 4, 7, and 8 are pending and elected. Claims 10-15 are non-elected claims. All pending elected claims have been finally rejected, and the rejections of the claims are hereby appealed. A copy of the claims is enclosed herewith as Appendix A.

(4) Status of Amendments

An amendment canceling Claims 1, 2, 6, and 8, rewriting Claims 3 and 7 in independent form, and amending dependent claims 4 and 8 to comport therewith has been filed for focus the issues on appeal.

(5) Summary of Invention

As recited in Claim 3, the invention is a tubular skylight that has a seamless metal flashing, a transparent dome engageable with the flashing, and a skylight tube depending downwardly from the flashing. The flashing has a hollow frusto-conical shaped curb defining an open top that is covered by the dome and a bottom opposite the open top. A skirt extends radially away from the bottom of the curb. The skirt defines a radial dimension, and the skirt is formed with plural ribs, each rib being oriented radially on the skirt.

Claim 7 recites a roof flashing that has a hollow frusto-conical shaped curb defining a bottom end and a metal skirt extending radially away from the bottom end. The skirt is formed with plural ribs oriented radially on the skirt.

(6) Issues

- (a) Whether prosecution has been properly reopened after a decision by the Board without remand for a new search;
- (b) Whether Clarke et al. is analogous art;
- (c) Whether the Claims are unpatentable under 35 U.S.C. §103 as being unpatentable over Chao et al. in view of Deutsch et al. and further in view of Clarke et al.; and
- (d) Whether the Claims are unpatentable under 35 U.S.C. §103 as being unpatentable over Deutsch et al. in view of Chao et al. and further in view of Clarke et al.

(7) Grouping of Claims

The Claims are grouped together.

(8) Argument

- (a) The Board is invited to consider whether prosecution can be properly reopened for a new search after a Board reversal of all previous rejections, when the Board did not indicate a remand for a new search in its prior decision. The examiner, who was not the examiner originally appealed, purports compliance with MPEP §1214.04. However, this section explicitly states that

"The examiner should *never* regard such a [Board] reversal as a challenge to make a new search to uncover other and better references. *This is particularly so where the application has been transferred to an examiner other than the one who rejected the claims leading to appeal. The second examiner should give full faith and credit to the prior search*" (emphasis mine).

How conducting a new search in this instance comports with the above language is indeed mysterious.

The examiner next relies on MPEP §704.01, but has appeared to overlook the fact that Chapter 700 applies to general examination pre-appeal, and that it cannot take precedence over contrary guidance in Chapter 1200 that is specifically directed to post-appeal action. Moreover, the relied-upon section of Chapter 700 again repeats that full faith and credit are to be given to a prior examiner's search, unless there is clear error in the action taken or knowledge of the prior art. The examiner now evidently contends there was such clear error, but without elaborating on what it might have been. The "clear error" being complained of presumably is not of the action taken, because the "action taken" would refer to the reversal by the Board. And, no evidence has been presented as to why the examiner and the Board clearly erred in their knowledge of the prior art. Indeed, the Board's thorough opinion reversing the prior rejections evidences a keen understanding of the prior art. Reliance on this section of the MPEP for the examiner's behavior thus appears to be misplaced.

The examiner then attempts to make two lawyerly arguments about MPEP §1214.04 which, like many such arguments, are too clever by half. He first argues that the third paragraph "provides clear authority" to reopen prosecution. Indeed it does, but only under limited circumstances that the examiner fails to mention, namely, when the examiner has *specific* knowledge of references indicating unpatentability. Despite the examiner's representation to the contrary, this was plainly not the case here, since the new references

being applied against Claims 3 and 7 (Clarke et al. and Deutsch et al.) were all uncovered pursuant to a new search that yielded several other new references as well. If the examiner had "specific" knowledge of the three new references, why was a new search required to find them?

The "specific knowledge" proviso of the third paragraph does indeed make sense, however, when one reads it, in conjunction with the preceding prohibition against a new search, to permit the assertion of references that the examiner specifically knows of without having to dig them up from a search, e.g., patents currently before the examiner in another case. Otherwise, reading it as advocated by the examiner more or less has the effect of eliminating from the MPEP the above-quoted guidance against more searching post-decision absent a remand to do so.

The examiner then plays a little word game, noting that MPEP §1214.04 doesn't really prohibit a new search, it only prohibits an examiner from feeling "challenged" to perform one. This of course reduces the MPEP from an objective source of procedural authority to an advisory document the compliance with which depends on an examiner's subjective state of mind and discretionary proclivity to engage in semantics. The fact that this argument is being made at all demonstrates the bankruptcy of the examiner's purported support for authority to do what he did.

The examiner concludes his rationalizing with the observation that "in any event, if the claimed subject matter is unpatentable, applicant is not entitled to it under any circumstances." This bears more than a whiff of pleading that the end justifies the means, a particularly odious attitude in a federal agency whose permissible conduct is supposed to be clearly authorized in writing, not merely hinted at or justified after the fact as a *fait accompli*. What Appellant is arguing here is not the substantive merits of the new art uncovered during the search, which are dealt with below, but conduct by a Patent Office employee that plainly finds no

clear authorization in the Patent Office's own procedures and that, if anything, appears to be discouraged by the MPEP.

It may be that despite MPEP Chapter 1200, the Patent Office favors new searching after a Board reversal without remand for a search. It may also be that although Appellant believes the examiner's rationale is on shaky ground, the Board may agree with it. If that is the case, it nonetheless should be indisputable that in light of the above-discussed sections of the MPEP, the MPEP is less than clear on this point. In that event, it is respectfully suggested that the MPEP be amended to clearly state that an examiner may conduct a new search after a Board reversal without remand to do so, so that the public has fair notice that such conduct might be expected.

8(b)

Clarke et al. is non-analogous art. It is directed to sewer manhole covers, not skylights. Why the skilled artisan would stoop that low from his perch on the roof for ideas is an enigma. The examiner breezily states that the fact that Clarke et al. is from the sewer manhole cover art "is of little consequence" because "one of ordinary skill would have turned to known metal fabrication techniques". This ignores the inconvenient fact that what is being claimed is not some general "metal fabrication technique". To paraphrase the Board's correct observation in its prior decision, the test is not whether an examiner believes analogousness to be of little consequence or not, but rather whether the sewer manhole cover of Clarke et al. would have logically commended itself to the skylight artisan. The present rejections most plainly fail this test.

8(c)

The Claims are patentable over Chao et al. in view of Deutsch et al. and further in view of Clarke et al. The primary reference, Chao et al., was before the Board previously, and as stated above, Clarke et al. is not even from the skylight art. There is thus no motivation to combine the rib of Clarke et al. with the skylight of Chao et al., since it has not been shown that sewer manhole cover fabrication techniques are readily transferable to the skylight art.

MPEP §2143.01 requires that the suggestion to combine references must come from the prior art. Chao et al. does not mention that its flashing can be seamless or that it can have radial ribs as claimed. The "ribs" of Deutsch et al. are not radial nor are they suggested to be, as conceded in the examiner's use of Clarke et al.

Clarke et al. nowhere suggests that its manhole cover or any portion thereof such as the ribs would work with a skylight flashing, and in fact does not even mention skylights. There is thus no teaching or suggestion that the manhole cover ribs of Clarke et al. could be suitably modified and work for its intended purpose in the context of skylights. There is no suggestion or expectation that the principles for which Clarke et al. uses its ribs - for purposes related to infilling concrete in a flat manhole cover - would readily translate to round skylight flashings that are not flat but rather have a curb rising from a skirt and that do not use concrete in any way, nor has any prior art evidence been adduced that the skilled skylight artisan would descend to the realm of the sewer for ideas related to skylight flashings.

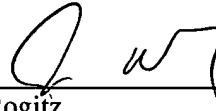
8(d)

The claims are patentable over Deutsch et al. in view of Chao et al. and further in view of Clarke et al. for the reasons advanced above.

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Page 8

PATENT
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Respectfully submitted,



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JLR:jg

APPENDIX A

3. A tubular skylight comprising:
 - a seamless metal flashing;
 - a transparent dome engageable with the flashing;
 - at least one skylight tube depending downwardly from the flashing, wherein the flashing comprises:
 - a hollow frusto-conical shaped curb defining an open top, the open top being covered by the dome, the curb defining a bottom opposite the open top; and
 - a skirt extending radially away from the bottom of the curb, wherein the skirt defines a radial dimension, and the skirt is formed with plural ribs, each rib being oriented radially on the skirt.
4. The skylight of Claim 3, wherein the skirt defines an outer periphery, and the skirt includes a rib formed along at least part of the periphery.
7. A roof flashing, comprising:
 - a hollow frusto-conical shaped curb defining a bottom end; and
 - a metal skirt extending radially away from the bottom end, the skirt being formed with at least one surface strengthening anomaly, wherein the surface strengthening anomaly is a rib, the skirt defines a radial dimension, and the skirt is formed with plural ribs, each rib being oriented radially on the skirt.
8. The roof flashing of Claim 7, wherein the skirt defines an outer periphery, and further includes at least one rib formed along at least part of the periphery.